REMARKS

Claims 15, 17-19, and 21-22 are pending after entry of the above amendments. Claims 15 and 19 have been amended to include the features of dependent Claims 16 and 20, respectively, and thus Claims 16 and 20 have been canceled. Claims 23-26 have also been canceled without prejudice. Claims 15-17 and 19-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over WO 2003/080999 to Erdmann et al. in view of U.S. Patent No. 5,231,831 to Leavesley. Claims 18 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Erdmann in view of Leavesley, and further in view of WO 2001/0053679 to Bernardini et al. Claims 23, 25, and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Erdmann in view of Bernardini. Claim 24 was rejected under 35 U.S.C. 103(a) as being unpatentable over Erdmann in view of Bernardini, and further in view of Leavesley.

Summary of Claim Amendments

As noted, Applicant has amended Claims 15 and 19 to include the features of respective dependent Claims 16 and 20. The added features specify that the piston has a radial thickness defined between a radially outer surface and a radially outer surface of the piston, and the slots in the piston that receive at least the dividing vanes *extend radially inwardly from the radially outer surface of the piston for a radial distance less than the radial thickness of the piston, such that the slots do not go all the way through to the radially inner surface of the piston.*

Response to the Rejections of Claims 16 and 20

Dependent Claims 16 and 20 (which now correspond to independent Claims 15 and 19) were rejected as unpatentable over Erdmann and Leavesley. The Office Action asserted that the turbocharger of Erdmann as modified by Leavesley "comprises the slots in the piston extend radially inwardly less than a fully [sic, full] radial thickness of the piston, such that the slots do not go all the way through to a radially inner side of the piston." The Office Action further asserted that Leavesley discloses slots in the piston that extend radially inwardly from a radially outer side of the piston (Fig. 13).

Applicant respectfully submits that Erdmann and Leavesley would not have suggested the arrangement as claims in Claims 15 and 19. U.S. Patent No. 7,047,739 is an English equivalent of Erdmann, and will be referred to below. Erdmann's turbocharger has a piston defining a wall 16 having openings 18 that receive vanes 10. Erdmann depicts the openings 18 in Figures 1 and 4, and describes them in the passage at col. 4 line 47 to col. 5 line 6 of the '739 patent:

> "On the end face opposite the fixed wall 15, the radial flow inlet passages 6 and 7 are delimited axially by a second axially displaceable wall 16 which is designed to be displaceable in the direction of the longitudinal axis of the turbocharger. For this purpose, the displaceable wall 16 is connected to a sliding sleeve 17 which is arranged in the outflow duct 14 in an axially displaceable manner and can be actuated via an actuating element, not shown. *On its side facing the fixed wall 15, the displaceable wall 16 has one or more locating openings 18* which extend over the circumference of the wall 16 and run in the axial direction. When the displaceable wall 16 approaches the fixed wall 15, these locating openings 18 serve to accommodate the guide cascade ring 10 or the guide vanes of the guide cascade ring 10. In this way, it is possible to reduce the distance between the walls 15 and 16 to such an extent that both walls 15 and 16 are in contact with one another and the radial flow inlet passages 6 and 7 are completely closed or are closed except for a remaining gap. In this way, the combination turbine can be reduced to a semi-axial turbine. By the radial guide cascade ring 10 being receivable in the locating openings 18, the radial flow inlet passages 6 and 7 can be adjusted in an infinitely variable manner. *In order to ensure an optimum incident flow to the radial guide cascade ring 10 and to the turbine wheel 3 irrespective of the axial position of the adjustable wall 16, the adjustable wall 16 also has a fluidically favorable contour over its radially outer side.*

Erdmann's description of the items 18 as "openings" in the side of the wall 16 facing the fixed wall 15 suggests that the openings 18 are not slots that extend into either the radially outer surface of the piston (which is further supported by the last sentence above in italics) or the radially inner surface of the piston.

Leavesley, on the other hand, appears to show a piston 24 having slots 10 that extend into the radially outer surface of the piston and through the radially inner surface of the piston as well (Fig. 13). In other words, the slots 10 extend fully through the radially thickness of the piston.

Claims 15 and 19 require that the piston has a radial thickness defined between a radially outer surface and a radially outer surface of the piston, and the slots in the piston that receive at

least the dividing vanes extend radially inwardly from the radially outer surface of the piston for a radial distance less than the radial thickness of the piston, such that the slots do not go all the way through to the radially inner surface of the piston. The cited references teach either openings that are completely contained between the radially outer and inner surfaces of the piston (Erdmann), or slots that extend through the entire radial thickness of the piston (Leavesley), neither of which corresponds to what is claimed in Claims 15 and 19. To perceive these references as teaching the claimed arrangement requires the use of an impermissible degree of hindsight, in Applicant's opinion.

Accordingly, it is submitted that Claims 15 and 19 are not suggested by, and are patentable over, Erdmann and Leavesley. All remaining claims depend from these independent claims and thus are patentable for at least the reasons applicable to the independent claims.

Based on the above amendments and remarks, it is submitted that the application is in condition for allowance.

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